

Applicants: Guy Benchley et al.
Application No.: 10/809,946

REMARKS

The Claim Amendments

Applicants have amended claims 1, 10, 11, and 39 to correspond the claims to elected group I. Support for these amendments is found in the original claims.

Claim 1 has been amended such that each occurrence of Z is defined as an optionally substituted C₁-C₆ alkylidene chain, wherein up to three non-adjacent methylene units are optionally replaced by a list of possible chemical linkers. Support for this amendment is found in [0050] on page 17 of the specification.

Claims 2-6, 20-30, 33, and 41 have been canceled.

Applicants have amended claim 7 such that each of Q-R⁵ is defined as being a methyl group and claim 8 such that one of Q-R⁵ is defined as being a trifluoromethyl group. Support for these amendments is found in [0046] on pages 15-16.

Claim 10 has been amended to delete the alternative embodiment wherein R¹ or R² can be TR. Support for this amendment finds support in the claims as originally filed and in the corresponding specification text.

Claim 12 has been amended to include the term "Z is a bond or" and replace the term "C₀₋₄ alkylidene chain" with "C₁₋₄ alkylidene chain." Further, claims 31 and 33 have been amended to replace the term "C₀₋₄ alkylidene chain" with "C₁₋₄ alkylidene chain." These amendments improve claim form or remove redundant claim elements and find support in [0074] on page 28 of the specification.

In claims 12 and 13, the alternative embodiment of R³ and R⁴ forming a ring has been removed. Support for these amendments finds support in the claims as originally filed and in the corresponding specification text.

Claims 14, 32, and 34 have been amended to redefine R³ and R⁴ and to include a definition for m and n. Support for these amendments is found in [0054] on pages 18 and 19 of the specification.

Claims 31-39 have been amended to correct their dependencies appropriately. Support for these amendments is found in the original claims.

Claim 43 has been amended such that it recites a method of inhibiting kinase

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activity in a biological sample. Support for this amendment is found in the claim as originally filed and the corresponding specification text.

Claims 44 and 46 have been amended to recite diseases treated by the claimed methods. Support for these amendments is found in [00140] to [00147] on pages 79-80.

None of the amendments contain new matter. Their entry is requested.

The Restriction

The Examiner has required a restriction in the above-identified application under 35 U.S.C. § 121 to one of the following two groups:

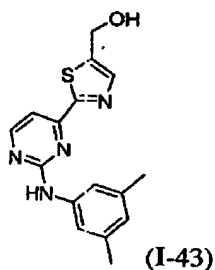
I. Claims 1-47, drawn to compounds of formula I, wherein R^1 and R^2 are independent substituents and are NOT taken together to form a ring, corresponding composition and method of use; and

II. Claims 1-38 and 40-47, drawn to compounds of formula I, wherein R^1 and R^2 are taken together to form a ring, corresponding composition and method of use.

Applicants elect Group I without traverse.

The Election of Species

The Examiner has required an election of species under 35 U.S.C. § 121. Applicants elect species I-43 with traverse. The structure of I-43 is as follows:



Claims 1, 7, 9, 10, 11, 14, 15, 19, 31, 33, 34, 36, 39, 40, and 42-47 read on the elected species.

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Applicants traverse because it appears that the Examiner is making a restriction requirement for each species encompassed by the elected invention, even though the requirement is phrased as an election of species. Under 37 CFR § 1.141(a), more than one species of an invention may be specifically claimed in an application provided that the application also includes an allowable generic claim to all claimed species.

In the instant application, (i) each claimed species falls within the scope of generic formula I of claim 1, and (ii) the number of species claimed is not unreasonable and would not constitute an undue search burden on the Examiner.² In addition, a restriction based upon a single species would prevent Applicants from properly claiming their invention (see MPEP § 803.02). The instant invention encompasses all species defined in the claims, including certain species that have not been exemplified in the specification. Thus, a restriction requirement that requires election of a single disclosed species would prevent Applicants from claiming those aspects of their invention for species that are encompassed by the generic claims but are not specifically disclosed. For these reasons, Applicants respectfully request that the Examiner withdraw the restriction requirement as it relates to an election of species.

The elections made herein are made expressly without waiver of applicants' rights to continue to prosecute and to obtain claims to the non-elected subject matter either in this application or in other applications claiming benefit herefrom.

² A search of the entire subject matter of groups I and II claimed in the corresponding PCT application has been conducted by the European Patent Office, as indicated in the International Search Report submitted with the Information Disclosure Statement filed on August 26, 2005 for the instant application. Four references of particular relevance were cited in the Search Report.

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Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,



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